

related applications. Claim 30 has been amended to delete extraneous language. Claim 38 has been amended to change "wherein" in the definition of variable "F" to "or", thus correcting a typographical error.

Applicants have rewritten claims 11, 14, 16, 25-29, and 34-36 in independent form as new claims 39-49, respectively. Claims 39-41 additionally contain the limitation found in amended claim 37, and claims 42-46 additionally contain the correction mentioned above in connection with claim 38.

Claims 1, 5, 8-10, 18-20, 22-24, 30-33 and 37-38 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by Egholm, M. et al., *J. Chem. Soc. Chem. Commun.* 1993 800-801 ("Egholm et al.").

As a preliminary matter, Applicants respectfully assert that the finality of the present Office Action is improper. The Office Action states that Applicants' amendment necessitated the rejection over Egholm et al.<sup>1</sup> The Office Action further appears to indicate that the rejection is necessitated by "amendment regarding newly added claims." However, the "new" claims were added in response to the Communication mailed July 8, 1997, and were stated by Applicants to be substantively identical to

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<sup>1</sup> The Office Action is not specific in this regard, but Applicants assume that the Office Action intends to refer to Applicants' amendment of April 3, 1997.

amended claims 7 and 21. Moreover, in Applicants' amendment, the scope of claims 7 and 21 were narrowed to define certain preferred embodiments of the invention. It is not seen how such claims could be now subject to a rejection under 35 U.S.C. § 102(b) to which the prior, unamended claims were not also subject. Accordingly, Applicants assert that the present rejection was not necessitated by Applicants' amendment, and respectfully request that the finality of the Office Action be withdrawn.

The Office Action asserts that the Egholm reference anticipates the present claims because it allegedly discloses "PNA monomers with lysine attached at termini as a conjugate" and because lysine allegedly falls within the definition of "a crosslinking reagent." However, Applicants wish to bring to the attention of the Examiner PCT application EP/01219, which was filed May 22, 1992, the benefit of which is claimed under 35 U.S.C. § 119 in the present application. A copy of the EP/01219 application is provided herewith. The EP/01219 application discloses lysine-terminated PNAs at, for example, Example 71 *et seq.* Accordingly, the Egholm reference is not available as a prior art reference in this application.

Moreover, Applicants have amended the claims to exclude lysine crosslinking agents. This amendment was made solely to distinguish the claims in the present case from those pending or

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allowed in prior related applications, such as, for example, U.S. Ser. No. 08/108,591, filed November 22, 1993, the prosecution of which is currently stayed pending the outcome of an interference.

Although the Egholm et al. reference is not prior art against the claims of the present application, as discussed above, Applicants nevertheless wish to point out that the compounds disclosed in Egholm et al. are not within the scope of Applicants' claims. For example, rejected claims 5, 22-24, 30-33 and 38 (as well as new claims 42-49) recite monomeric PNA compounds, whereas the Egholm et al. reference discloses polymeric PNA compounds having a terminal lysine residue. While the other rejected claims (1, 8-10, 18-20 and 37) and new claims 39-41 relate to polymeric PNA conjugates, they nevertheless specify that where the compounds contain a terminal crosslinking agent, that crosslinking agent is not lysine. Accordingly, even were the Egholm et al. reference to be prior art (which it is not, for the reasons explained above), this rejection under 35 U.S.C. § 102(b) still could not be maintained.

In view of the preceding remarks, reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) is respectfully requested.

In view of the foregoing, Applicants submit that the claims presently before the Examiner patentably define the invention over the applied art and are otherwise in condition for ready


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RESPONSE UNDER 37 CFR 1.116  
EXPEDITED PROCEDURE  
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allowance. An early Office Action to that effect is, therefore,  
earnestly solicited.

Respectfully submitted,

  
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